

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed October 1, 2003. At the time of the Office Action, Claims 1-15 and 17-85 were pending in the Application. Applicant amends Claims 1, 3, 38, 48-49, and 84-85. The amendments are not necessarily the result of any prior art reference and thus do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments are without prejudice or disclaimer. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1, 3, 11, 17, 19, 36, 38-41, 47-49, 57, 63, 65, 82, and 84-85 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,434,616 issued to Urano et al. ("*Urano*"). Applicant is perplexed by the appearance of *Urano*, as attorneys for Applicant and Examiner Burgess discussed how *Urano* is clearly distinguishable from the pending claims. Applicant presents the following analysis of *Urano* once more and respectfully urges the Examiner to evaluate *Urano* more closely, as it is not germane to the patentability of the pending claims. Applicant has also made a series of amendments to some of the pending claims in order to remove the phrase "a statistics gathering operation." Applicant does not believe that any of the references teach such an element, but has made the amendments in order to advance prosecution of this case. Perhaps such an element could be construed within the rubric of tracking "log information," which the Examiner's primary reference (*Urano*) discloses. The pending claims are clearly patentable over *Urano* and Applicant has made these minor amendments in order to avoid confusion and make this issue abundantly clear for the Examiner.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."² In regard to

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

inherency of a reference, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

Independent Claims 1, 3, 38, 48, and 49 recite, in general, receiving instructions that indicate how packets received by the forwarding agent are to be processed and processing the packets according to the instructions. In contrast to these teachings, *Urano* discloses a method, the patent being entitled: A Method For Monitoring Abnormal Behavior in a Computer System. The method includes collecting log information in order to detect an event. (See *Urano*, Column 2, lines 61-67.) Throughout *Urano*, the audience is informed of the importance of logging information. For example, at one passage in the Background Section of *Urano*, the following is disclosed: “...methods for transferring various types of computer logs over a network for monitoring on another computer have been widely used. However, most of those methods transfer all logs, increasing the network load and sometimes developing a problem especially when the amount of log data produced by the sending computers exceeds the network transfer capacity.” (See Column 1, lines 13-19.) Remaining with the Background Section, *Urano* continues: “...administrators must associate log messages sent from one computer with those sent from another computer or obtain more detailed information on the logs depending upon the output log...Conventionally, log information has been written directly to non-volatile storage. Log information is also written via a network to non-volatile which is usually remote non-volatile storage.” (See Column 1, lines 37-52.) The Background Section ostensibly sets up the Summary Section, which provides “It is an object of the present invention to provide a method of collecting an amount of log information enough to keep track of the status of agents without heavy processing load on both the network and the manager computer...It is still another object of the present invention to provide a method of automating the association of log information output by a plurality of computer and, depending upon the output information, the collection of more detailed information in order to reduce the load

³ See MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis original*)).

⁴ See MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis original*)).

on an administrator...To achieve the above objects, the method according to the present invention concurrently monitors log information collected from a plurality of computers and integrally checks the validity and consistency of the log information to find an invalid action.” (See Column 1, lines 60-22.)

How any of this disclosure from *Urano*, in any way, anticipates the teachings of any of the pending claims is unclear. Applicant tested the bounds of his imagination in order to try and objectively evaluate *Urano* as somehow being relevant to the pending subject matter. Applicant is at a loss as to how anything having to do with keeping track of log information or ensuring the validity of log information relates to the forwarding agent and service manager disclosed by the above-identified claims. Moreover, Applicant consulted a dictionary to ascertain any other potential meanings associated with “log.” According to the most relevant definition for this case, “log” is defined as: a record, as of the performance of a machine. *The American Heritage College Dictionary* 787 (3rd Ed. 1997). Again, Applicant reminds the Examiner that such a definition truly reveals how remote *Urano* is to the patentability of the pending claims.

Turing to the architecture of *Urano* in more detail, when one of the manager computer 104, console computer 106, and operator 105 detects an abnormal condition, the manager computer 104 collects more detailed [log] information. (See *Urano*, Column 5, lines 37-40.) In the example offered by *Urano*, the manager computer 104 supposes that an event has occurred and collects the logs to verify it. The method purportedly reduces the load on the manager computer 104 necessary to make an analysis and minimizes network traffic. (See *Urano*, Column 6, lines 5-13.) However, nowhere in *Urano* is there any disclosure, teaching, or suggestion of receiving instructions and processing packets according to the instructions as recited in the above-identified claims. Applicant pointed out as much in the previous response, which was a result of the Examiner's Office Action of October 3, 2002. While it is true that an instruction is provided in the system of *Urano*, that instruction is incapable of indicating how packets are to be processed. Moreover, the “instruction” disclosed by *Urano* reflects rules governing which log is important and which log should be sent to the manager computer. (See *Urano* generally at Column 4, lines 28-52.) This is not akin to receiving instructions and processing packets according to the instructions as recited in the above-identified claims. For at least this reason, these claims are patentable over *Urano*. Additionally, Claims 11, 17, 19, and 36 depend from

Independent Claim 3 and are therefore also allowable over *Urano*. Also, Claims 39, 40, 41, and 47 and Claims 57, 63, 65, and 82 depend from Independent Claims 38 and 49 respectively and are therefore also allowable over *Urano* for similar reasons. Accordingly, *Urano* does not anticipate Claims 1, 3, 11, 17, 19, 36, 38-41, 47-49, 57, 63, 65, 82, and 84-85. Notice to this effect is respectfully requested in the form of an allowance of these claims.

Section 103 Rejections

The Examiner rejects Claim 2, 16, and 62 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,243,748 issued to Arai ("*Arai*"). Claim 1, from which Claim 2 depends, has been shown to be patentably distinct from *Urano*. Claim 3, from which Claim 16 depends, has been shown to be patentably distinct from *Urano*. Claim 49, from which Claim 62 depends, has also been shown to be patentably distinct from *Urano*. Also, in contrast to Claims 2, 16, and 62 *Arai* discloses a method and apparatus for managing a large scale network including apparatuses to be managed. *Arai* fails to provide any disclosure that would teach or suggest the appropriate claim limitations as is required for a proper §103 analysis. Moreover, *Arai* fails to offer any additional subject matter combinable with *Urano* that would be material to patentability. For example, neither *Arai* nor any other reference of record offers any suggestion or motivation to make the proposed combination as is required by MPEP §2143. Therefore, Applicant respectfully submits that Claims 2, 16, and 62 are patentably distinct from the proposed *Urano-Arai* combination.

The Examiner rejects Claims 4, 6, 10, 16, 50, 52, 56, and 62 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 5,961,595 issued to Kawagoe ("*Kawagoe*"). Claims 3 and 49, from which Claims 4, 6, 10, and 16 and Claims 50, 52, 56, and 62 respectively depend, have been shown to be patentably distinct from *Urano*. Also, in contrast to the subject matter of these claims, *Kawagoe* discloses a network management system with a hardware resource management module shared between networks. *Kawagoe* fails to provide any additional disclosure that would teach or suggest all of the claim limitations as is required for a proper §103 analysis. Moreover, *Kawagoe* fails to offer any additional subject matter combinable with *Urano* that would be material to patentability. Neither *Kawagoe* nor any other reference of record offers any suggestion or motivation to make the proposed combination. Additionally, the Examiner has also failed to show that

such a combination could have been based on the knowledge available to one having ordinary skill in the art. Therefore, Applicant respectfully submits that Claims 4, 6, 10, 16, 50, 52, 56, and 62 are patentably distinct from the proposed *Urano-Kawagoe* combination.

The Examiner rejects Claims 12, 34, 35, 37, 58, 80, 81, and 83 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,407,997 issued to DeNap ("*DeNap*"). Claims 3 and 49, from which Claims 12, 34, 35, and 37 and Claims 58, 80, and 81 respectively depend, have been shown to be patentable over *Urano*. Also, in contrast to the subject matter of these claims, *DeNap* discloses an asynchronous transfer mode system for providing telephony service. *DeNap*, however, fails to provide any additional disclosure that would teach or suggest all of the claim limitations. *DeNap* also fails to offer any additional subject matter combinable with *Urano* that would be material to patentability. For example, neither *DeNap* nor any other reference of record offers any suggestion or motivation to make the proposed combination or that such a combination could have been based on the knowledge available to one having ordinary skill in the art. Therefore, Applicant respectfully submits that Claims 12, 34, 35, 37, 58, 80, 81, and 83 are patentably distinct from the proposed *Urano-DeNap* combination.

The Examiner rejects Claims 13 and 59 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,363,072 issued to Furuichi ("*Furuichi*"). Claims 3 and 49, from which Claims 13 and 59 respectively depend, have been shown to be patentable distinct from *Urano*. Additionally, in contrast to the subject matter of these claims, *Furuichi* discloses an ATM network communication control system allowing end-to-end connection to be set up with ease. *Furuichi* fails to provide any disclosure that would teach or suggest all of the claim limitations of Claims 13 and 59. Moreover, *Furuichi* fails to offer any additional subject matter combinable with *Urano* that would be material to patentability. Neither *Furuichi* nor any other reference of record offers any suggestion or motivation to make the proposed combination. Therefore, Applicant respectfully submits that Claims 13 and 59 are patentably distinct from the proposed *Urano-Furuichi* combination.

The Examiner rejects Claims 14 and 60 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,065,061 issued to Blahut et al. ("*Blahut*"). Claims 3 and 49, from which Claims 14 and 60 respectively depend, have been shown to be allowable from *Urano*. Additionally, *Blahut* discloses an internet protocol based network architecture for cable television access with switched feedback. *Blahut*, however, fails to provide any

disclosure that would teach or suggest all of the claim limitations of Claims 14 and 60 as is required for a proper §103 analysis. Moreover, *Blahut* fails to offer any additional subject matter combinable with *Urano* that would be material to patentability. For example, neither *Blahut* nor any other reference of record offer any suggestion or motivation to make the proposed combination or that such a combination could have been based on the knowledge available to one having ordinary skill in the art. Therefore, Applicant respectfully submits that Claims 14 and 60 are patentably distinct from the proposed *Urano-Blahut* combination.

The Examiner rejects Claims 15, 43, and 61-62 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,125,390 issued to Touboul ("*Touboul*"). Claims 3, 38, and 49, from which Claims 15, 43, and 61 respectively depend, have been shown to be allowable over *Urano*. Also, in contrast to the subject matter of these claims, *Touboul* discloses a method and apparatus for monitoring and controlling in a network. *Touboul* fails to provide any disclosure that would teach or suggest all of the claim limitations as is required for a proper §103 analysis. Moreover, *Touboul* fails to offer any additional subject matter combinable with *Urano* that would be material to patentability. For example, neither *Touboul* nor any other reference of record offers any suggestion or motivation to make the proposed combination. Therefore, Applicant respectfully submits that Claims 15, 43, and 61 are patentably distinct from the proposed *Urano-Touboul* combination.

The Examiner rejects Claims 18 and 64 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,070,187 issued to Subramaniam et al. ("*Subramaniam*"). Claims 3 and 49, from which Claims 18 and 64 respectively depend, have been shown to be allowable over *Urano*. Additionally, *Subramaniam* discloses a method and apparatus for configuring a network node to be its own gateway. *Subramaniam*, however, fails to provide any disclosure that would teach or suggest all of the claim limitations of Claims 18 and 64. Moreover, *Subramaniam* fails to offer any additional subject matter combinable with *Urano* that would be material to patentability. For example, neither *Subramaniam* nor any other reference of record offers any suggestion or motivation to make the proposed combination. Therefore, Applicant respectfully submits that Claims 18 and 64 are patentably distinct from the proposed *Urano-Subramaniam* combination.

The Examiner rejects Claims 21-33, 42, 44-46, and 67-79 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,172,980 issued to Flanders et al.

("Flanders"). Claims 3 and 49, from Claims 21-23 and Claims 42-46 and 67-79 respectively depend, have been shown to be allowable over *Urano*. Also, *Flanders* discloses a method and apparatus for determining agent availability based on a level of uncompleted tasks. But *Flanders* fails to offer any disclosure that would teach or suggest all of the claim limitations as is required for a proper §103 analysis. Moreover, *Flanders* fails to offer any additional subject matter combinable with *Urano* that would be material to patentability. For example, neither *Flanders* nor any other reference of record offers any suggestion or motivation to make the proposed combination or that such a combination could have been based on the knowledge available to one having ordinary skill in the art. Therefore, Applicant respectfully submits that Claims 21-33, 42-46, and 67-79 are patentably distinct from the proposed *Urano-Flanders* combination.

The Examiner rejects Claims 20 and 66 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of *Arai*. Claims 3 and 49, from which Claims 20 and 66 respectively depend, have been shown to be allowable over *Urano*. Moreover, *Arai* fails to provide any additional disclosure combinable with *Urano* that would be material to patentability. Accordingly, Claims 20 and 66 are patentably distinct from the proposed combination.

Claims 5 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of *Kawagoe* and in further view of *Arai*. Claims 3 and 49, from which Claims 5 and 51 respectively depend, have been shown to be allowable over *Urano*. Moreover, *Kawagoe* fails to provide any additional disclosure combinable with *Urano* or *Arai* that would be material to patentability. Accordingly, Claims 5 and 51 are patentably distinct from the proposed combination.

Claims 7 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of *Kawagoe* and in further view of *DeNap*. Claims 3 and 49, from which Claims 7 and 53 respectively depend, have been shown to be allowable over *Urano*. Moreover, neither *Kawagoe* nor *DeNap* provide any additional disclosure combinable with *Urano* that would be material to patentability. Accordingly, Claims 7 and 53 are patentably distinct from the proposed combination.

Claims 8 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of *Kawagoe* and in further view of *Furuichi*. Claims 3 and 49, from which Claims 8 and 54 respectively depend, have been shown to be allowable over *Urano*. Moreover, neither *Kawagoe* nor *Furuichi* provide any additional disclosure combinable with

Urano that would be material to patentability. Accordingly, Claims 8 and 54 are patentably distinct from the proposed combination.

Claims 9 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of *Kawagoe* and in further view of *Blahut*. Claims 3 and 49, from which Claims 9 and 55 respectively depend, have been shown to be allowable over *Urano*. Moreover, neither *Kawagoe* nor *Blahut* provide any additional disclosure combinable with *Urano* that would be material to patentability. Accordingly, Claims 9 and 55 are patentably distinct from the proposed combination.

Thus, the rejections associated with each of these references have been traversed, as illustrated by the analysis provided above. Accordingly, the remaining claims are allowable over the proposed combinations using similar reasoning. Additionally, the Examiner has yet to provide any evidence in any of the cited references, or in the knowledge available to one having ordinary skill in the art, to make any of the proposed combinations. Moreover, with regards to all of the proffered §103 rejections asserted, the Examiner is yet to show a modicum of evidence that would reflect any degree of success for the proposed combinations of references much less a reasonable degree of success as is required for a proper §103 analysis.

Thus, Applicant notes that the Examiner has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis. According to M.P.E.P. §2143, to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations.⁵ Applicant has identified how the Examiner has failed to provide any reference (or combination of references) that teaches or suggests all of the claim limitations.

With respect to the first criterion of non-obviousness, the Examiner has not shown a suggestion or a motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the cited references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art

⁵ See generally M.P.E.P. §2143.

suggests the desirability of making the combination.⁶ Thus, the fact that the teachings of one reference (*Urano*) would improve the teachings of another reference (any of the proffered §103 references), as posited by the Examiner, does not provide the required suggestion to make such a combination. Nothing in *Urano* or any other cited reference suggests or motivates the proposed combinations. Nor has the Examiner provided any evidence that suggests any of the proposed modifications.⁷ The Examiner merely speculates that “it would have been obvious” to make the proposed combinations. The Examiner is merely interjecting a subjective conclusory statement in an improper hindsight attempt at rejecting the claims without citing any language from any of the cited references to support the rejection. The Examiner presents no objective evidence from the prior art that suggests or motivates the combination as is required by Federal Circuit caselaw.⁸ The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.⁹

Furthermore, the Examiner is precluded from modifying the combined teachings of *Urano* and any of the other references in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.¹⁰ The fact that the modification is possible or even advantageous is not enough.¹¹ A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹²

⁶ See M.P.E.P. §2143.01.

⁷ If the Examiner is relying on “common knowledge” or “well known” art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. §2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicant respectfully requests that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. §2144.03.

⁸ In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not “evidence.” *Id*

⁹ See M.P.E.P. §2145. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to lack of suggestion in the prior art of the desirability of combining references.”), See also *In re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”)

¹⁰ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

¹¹ See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

¹² *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. The combinations of *Urano* and any of the references of record would not be capable of performing the operation required by the claimed invention. The proposed combinations (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that the proposed combinations would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

With respect to the third criterion of non-obviousness, the Examiner has not shown how the proposed combination teaches each and every limitation of the claimed invention. This has been evaluated thoroughly in the analysis provided supra. With no other supporting references that are combinable with *Urano*, all of the claim limitations have not been taught or suggested by the Examiner's currently proposed combination.

Accordingly, all of the pending claims are allowable and notice to this effect is respectfully requested in the form of a full allowance of Claims 1-15 and 17-85.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Although Applicant believes that no fees are due, the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
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